

Applicant : Khosravi, et al.
Appl. No. : 09/427,260
Examiner : B. Pelegriño
Docket No. : 702563.4004

Remarks

Claims 29-30, 55-57, and 59-62 are pending. In the Office Action, the Examiner rejected all pending claims under 35 U.S.C. § 103(a).

Applicant respectfully requests reconsideration of the application and claims in view of the following Remarks and in view of the expert testimony of Eric Leopold contained in the Rule 132 Declaration submitted herewith.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 29 and 30 for obviousness over U.S. Patent No. 5,800,520 (“the Fogarty patent” or “the ‘520 patent”) in view of U.S. Patent No. 5,441,515 (“the Khosravi et al. patent” or “the ‘515 patent”). The Examiner also rejected claims 55-57 and 59-62 for obviousness over U.S. Patent No. 5,895,406 (“the Gray et al. patent” or “the ‘406 patent”) in view of the Khosravi et al. patent. For the foregoing reasons, Applicant requests reconsideration and withdrawal of these rejections.

As to all of the Examiner’s stated rejections based upon combinations of the Fogarty and Khosravi patents, and the Gray and Khosravi patents, Applicant once again submits that the Examiner has failed to identify any teaching, either from the references or elsewhere, as to why a person of skill in the art would be motivated to combine the disparate teachings of these three patents in the manner done by the Examiner. In his response to Applicant’s previous arguments on this issue, the Examiner stated his recognition that obviousness can be established by combining or modifying the teachings of the prior art only where there is some teaching, suggestion, or motivation to do so found

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either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner stated that, in this case, “the features of Khosravi can be said to improve the stent of Fogarty.” This is, quite simply, an inadequate finding upon which to reject the present claims.

To begin with, it matters not whether the features described in a first reference “can be said to improve” a device shown in a second reference. There would be very few patents granted if this were the standard for proving a prima facie case of obviousness. Indeed, this rationale represents pure hindsight reconstruction, which is improper. Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1350, 1358 (Fed. Cir. 1998). Instead, the Examiner must show why someone of skill in the art would be motivated to combine the *specific* teachings of the cited references in the manner relied upon. Here, that means that the Examiner must show some teaching that would have motivated a person of skill in the art to combine the coiled sheet structure and/or the locking teeth mechanisms described in the Khosravi patent with either of the stent structures described in the Fogarty or Gray patents, and to do so without regard to any of the contrary teachings contained in those references. It is not enough to simply pick and choose these features from the reference disclosures and state that they represent desirable “improvements” and that, therefore, one would have been motivated to make the combination. See, e.g., WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339, 1359 (Fed. Cir. 1999). Against this standard, the Examiner has failed to demonstrate a prima facie case of obviousness, because such a showing cannot be made on the basis of these varied references. There simply is no teaching available, either from the references or elsewhere, that would supply

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the motivation to make the combination relied upon by the Examiner. Once again, Applicant respectfully requests withdrawal of the claim rejections made in reliance on combinations of these references.

Applicant has submitted with this response the Rule 132 Declaration of Eric Leopold, an expert in the art of stents and stent manufacturing. Mr. Leopold reviewed each of the Fogarty, Gray, and Khosravi patents, as well as the Examiner's contentions concerning whether a person of ordinary skill in the art would be motivated to combine their teachings. Mr. Leopold concluded that nothing in those patents or in the general knowledge of a person of ordinary skill in the art would have provided any suggestion or motivation to combine the references as the Examiner suggests. (See Leopold Decl., ¶ 7).

In fact, Mr. Leopold identifies information contained within those patents that would steer a person of ordinary skill in the art away from the Fogarty/Khosravi and Gray/Khosravi combinations relied upon by the Examiner. It has consistently been held that obviousness cannot be found where the prior art teaches away from a claimed solution. See, e.g., Micro Chemical, Inc. v. Great Plains Chemical Co., 103 F.3d 1538, 1546 (Fed. Cir. 1997); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579 (Fed. Cir. 1997). Noting that the Khosravi patent teaches structures and locking mechanisms that increase the likelihood of fibrin accumulation and thrombosis, and that a stated objective of the stents described in the Fogarty patent was to minimize hyperplasia caused by the interaction of the stent with the interior wall of the vessel, Mr. Leopold concludes that the information contained in the Khosravi patent would actually steer one of ordinary skill in the art away from such a combination. (Leopold Decl., ¶ 14). Mr. Leopold

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also noted that the Khosravi coiled sheet stent design and locking mechanisms are less flexible than simple tubular stents (like those described in the Gray patent), have protruding edges, and cause damage to the interior lining of healthy vessels. (Leopold Decl., ¶¶ 16-17). These features are contrary to objectives identified in the Gray patent, namely, to provide axially flexible stent designs that avoid “important disadvantages” of prior art stent designs. (Leopold Decl., ¶¶ 14-15). Accordingly, Mr. Leopold concludes that the Gray patent actually teaches away from the proposed combination of its teachings with those of the Khosravi patent. (Leopold Decl., ¶ 18).

The mere fact that several of the elements of Applicant’s claims may be found in the three cited references is simply not enough to support a *prima facie* case of obviousness, see In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998), and is certainly an insufficient showing in comparison to the above evidence negating obviousness. Indeed, the only support for making the combination is to use Applicant’s claims as a template, which is improper. Sensonics, 81 F.3d at 1570. For these reasons, Applicant respectfully requests reconsideration of the rejections made in the present Office Action, and allowance of claims 29-30, 55-57, and 59-62.

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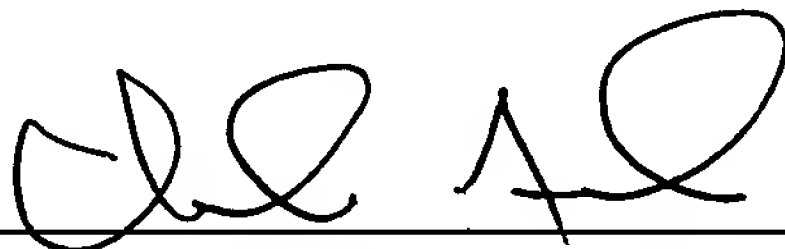
CONCLUSION

In view of the foregoing, it is submitted that the claims presented in this application define patentable subject matter over the cited prior art. Accordingly, reconsideration and allowance of the application is requested.

Respectfully submitted,

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